

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

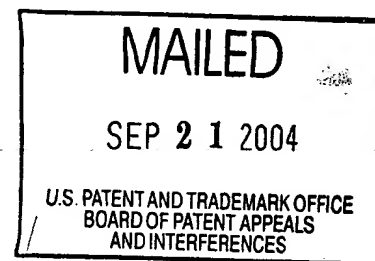
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALICE H. HOWE

Appeal No. 2004-2020
Application 09/655,743

ON BRIEF



Before FRANKFORT, STAAB, and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 15, all of the claims pending in this application.

Appellant's invention is directed to a tennis racket and ball retrieving attachment affixed to a shoulder region¹ of the racket for engaging and lifting a grounded tennis ball upon tangential contact of the retrieving attachment member with the outer surface of the ball, and to a method of using such a combination racket and ball retrieving attachment to permit a tennis player to merely extend the tennis racket to retrieve tennis balls from the court without the need to bend down to reach the balls by hand. More particularly, as noted on page 5 of the specification, appellant uses an industrial hook fastener material sold and distributed by the 3M Company, under their Scotchmate® brand of hook-and-loop fasteners, as the ball retrieving attachment member placed on a shoulder portion of the racket. The paragraph spanning pages 7 and 8 of the specification more specifically notes that it is the hook portion of Scotchmate® industrial fastener SJ3526 that is used in the present invention. The specification indicates and test results therein appear to demonstrate that when attached to a tennis racket shoulder portion and used as a ball retriever, the above-

¹As indicated on page 7 of appellant's specification, the outer perimeter of the head (6) of the tennis racket extending clockwise from about the eight o'clock to the four o'clock position is defined as the "shoulder region" of the racket.

Appeal No. 2004-2020
Application 09/655,743

noted Scotchmate® hook material exhibits unexpectedly superior efficacy in retrieving grounded tennis balls of all major tennis ball brands upon tangential contact therewith. Independent claims 1 and 10 are representative of the subject matter on appeal and a copy of those claims can be found in Exhibit A of appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Feldi	4,834,393	May 30, 1989
Urwin	4,993,712	Feb. 19, 1991
Melbye et al. (Melbye)	5,077,870	Jan. 7, 1992
Musslin	2,594,037	Aug. 14, 1987
(French reference)		

In addition to the above-noted prior art references, the examiner also relies upon what has been characterized as appellant's admitted prior art (hereinafter AAPA) found on pages 5-10 of the specification relating to Scotchmate® brand of hook-and-loop fasteners and, more specifically, to the hook fastener portion of Scotchmate® industrial fastener SJ3526 and the physical hook characteristics thereof.

Appeal No. 2004-2020
Application 09/655,743

Claims 1 through 7, 9, 10 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Feldi or Musslin either one taken in view of Melbye and AAPA.

Claims 8, 11 and 13 through 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Feldi, Musslin, Melbye and AAPA as applied above and further in view of Urwin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we refer to the Office action mailed June 19, 2001 (Paper No. 3) and the examiner's answer (Paper No. 15, mailed December 27, 2002) for the examiner's reasoning in support of the rejections and to appellant's brief (Paper No. 14, filed October 11, 2002) and reply brief (Paper No. 17, filed May 5, 2003) for the arguments thereagainst.

OPINION

Having carefully reviewed the obviousness issues raised in this appeal in light of the record before us, we have come to the conclusion that the examiner's rejections under 35 U.S.C. § 103

will not be sustained. Our reasons in support of this determination follow.

Concerning the examiner's rejection of claims 1 through 7, 9, 10 and 12 under 35 U.S.C. § 103(a), we note that while it is true that both Feldi and Musslin disclose a tennis racket and ball retrieving hooked fastener material affixed to a shoulder region of a racket for engaging and lifting a grounded tennis ball upon tangential contact of the retrieving attachment member with the outer surface of the ball, each of these references provides no more than a generalized generic teaching that some form of hooked fastener material should be used as the retrieving attachment to permit retrieval of grounded tennis balls from the court without the need to bend down to reach the balls by hand. More particularly, Musslin suggests use of a "mechanical adhesive, like a clothe (wrapper) with hooks, including catching elements made of smooth layers full of retention and natural, artificial, synthetic or even metallic fastening threads" (translation, page 2) as the ball retrieving member, while Feldi expressly teaches using an entire hook and loop fastening system (i.e., loop material as the covering on a tennis ball and a compatible hook material affixed to a shoulder region of the

racket) for engaging and lifting grounded tennis balls upon tangential contact of the hooked retrieving attachment member with the outer looped surface of the ball. Feldi generally suggests use of VELCRO "or any brand hook and loop fastening system" (Abstract).

Recognizing the shortcomings of the references to Feldi and Musslin vis-a-vis the particular type of hooked fastener material required in claims 1 and 10 on appeal, the examiner looks to the disclosure in the Related Art portion of the Melbye patent (col. 1, lines 15-18) that

[w]idely used as garment fasteners are hook-and-loop fasteners such as are currently marketed under the trademark VELCRO by Velcro USA Inc. and under the trademark SCOTCHMATE by 3M Co.

and asserts that

[c]ombining the fact that the Feldi abstract discloses that any hook-and-loop fastener system could be used in combination with his racquet or that Musslin discloses the broad recitation of a hook-and-loop fastener, with the fact that Melbye at column 1, lines 15-23 discloses that Velcro™ and Scotchmate™ products are functional equivalents as hook-and-loop fastener, and the fact that applicant admits in the specification that the materials with the physical characteristics set forth in the claims are old and well-known Scotchmate™ products, the selection of any of these known materials to form the hook-and-loop fastener of either Feldi or Musslin would be within the level of ordinary skill in the art. (Paper No. 3, pages 3-4).

What is lacking in both Feldi and Musslin is any teaching or suggestion that hook size (i.e., monofilament diameter, hook height, hook width and hook depth) are of any particular concern therein. This is especially true in Feldi, which relies upon the compatible nature of the selected hook and loop fastening system working together to retrieve the grounded tennis balls therein. Thus, Feldi has no concern whatsoever for any particular hook configuration and size, so long as the hook material on the tennis racket is compatible with the loop material on the ball. Similarly, Musslin provides no indication that hook size is of concern or of importance and merely suggests that any hook material which is capable of sticking on the tennis ball cloth envelope would be adequate.

The above-noted shortcomings in both Feldi and Musslin are in no way overcome by the teaching in Melbye that garment fasteners of hook and loop material are marketed under different trademarks by different companies (e.g., VELCRO by Velcro USA, Inc. and SCOTCHMATE by 3M). In that regard, we also note that there is no basis we can discern from the prior art relied upon for the examiner's apparent determination that any and all hook materials sold under the Scotchmate® brand of hook-and-loop

fasteners by 3M would necessarily (i.e., inherently) have hooks meeting the particular size limitations set forth in appellant's claims on appeal. In making the present rejection, the examiner has apparently failed to recognize that the fact that a claimed species or subgenus is encompassed by a broadly disclosed prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness, especially where, as here, the appellant has provided evidence indicating that the particular hook size of the hook material of the present invention is needed in order to provide sufficient hook tenacity, deeply penetrate the pile of a tennis ball, and consistently hold the ball after hooking and during lifting of the hooked ball from the ground.

As for the examiner's reliance on appellant's disclosure concerning a particular form of industrial grade hook material that provides superior ball-retrieving efficacy when used in the manner described in the present specification, we agree with appellant that in searching for an incentive for modifying the tennis racket of Feldi or Musslin the examiner has impermissibly drawn from appellant's own teachings regarding the deficiencies of the prior art and fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein

Appeal No. 2004-2020
Application 09/655,743

that which only the inventor has taught is used against its teacher." W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983).

Since it is our determination that the teachings and suggestions to be fairly derived from the prior art relied upon by the examiner would not have made the subject matter as a whole of independent claims 1 and 10 on appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a). It follows that the examiner's rejection of dependent claims 2 through 7, 9 and 12 under 35 U.S.C. § 103(a) will also not be sustained.

Regarding the examiner's further rejection of dependent claims 8, 11 and 13 through 18 under 35 U.S.C. § 103(a), we have reviewed the reference to Urwin, but find nothing therein which overcomes or provides for the deficiencies we have identified above with regard to the basic combination of prior art applied against independent claims 1 and 10. Accordingly, the examiner's rejection of dependent claims 8, 11, and 13 through 18 under 35 U.S.C. § 103(a) will likewise not be sustained.

Appeal No. 2004-2020
Application 09/655,743

In light of the foregoing, the decision of the examiner to
reject claims 1 through 15 under 35 U.S.C. § 103(a) is reversed.

REVERSED

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge

Lawrence J. Staab

LAWRENCE J. STAAB
Administrative Patent Judge

John P. McQuade

JOHN P. McQUADE
Administrative Patent Judge

)
)
)
) BOARD OF PATENT
)
) APPEALS AND
) INTERFERENCES
)
)

CEF:pgc

Appeal No. 2004-2020
Application 09/655,743

M. Paul Hendrickson
403 Main Street
P.O. Box 508
Holmen, WI 54636-0508